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BERKELEY LAW AND TECHNOLOGY GROUP
1700 N.W. 167TH PLACE, SUITE 240
BEAVERTON OR 97006

MAILED

OCT 07 2009

OFFICE OF PETITIONS

In re Application of	:	
Vinod Chintamani Malshe et al	:	
Application No. 10/552,422	:	DECISION ON PETITION
Filed: October 7, 2005	:	
Attorney Docket No. 044-P001	:	

This is a decision on the renewed petition, filed September 21, 2009, under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. *Note* 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

This application was held abandoned for failure to reply to the Notice of Non-Compliant Amendment (Notice) mailed August 26, 2008, which set a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of the Notice to reply. A Notice of Abandonment was mailed on March 17, 2009.

Petitioner asserts that the Notice mailed August 26, 2008 was not received.

BACKGROUND

A review of the written record indicates that the Notice mailed August 26, 2008 was returned to the U.S.P.T.O as undelivered on September 3, 2008. The Notice of Abandonment mailed March 17, 2009 was also returned on March 24, 2009.

Petitioner states that "On April 7, 2007, the physical and mailing addresses of the Attorneys of Record was changed to 17933 NW Evergreen Parkway, Suite 250, Beaverton, Oregon, 97006 ..."

Petitioner contends that the first time that Applicants' Attorneys were made aware of the Notice was a phone call from Examiner Caralynne Helm on March 2, 2009.

On March 3, 2009, a Change of Address was submitted. However, the change of address appears to be improper. The Attorney and Registration number is not of record in the instant application.

The Notice of Abandonment mailed on March 17, 2009, states that "the last correspondence from the Office was returned as undeliverable due to address change not being filed appropriately in application. Applicant's representative was telephoned and notified of issue."

THE PRESENT PETITION

Petitioner files the present petition and asserts that the Attorneys of Record, changed their mailing address of record with the USPTO via an Electronic Filing on May 15, 2007, and that the physical office location change was on April 7, 2007. Petitioner submitted as evidence, a copy of Exhibit B, an email received from Else Mebrahtu of the Patent Electronic Business Center of the USPTO to show that the address for the attorneys of record was changed on May 15, 2007.

The correspondence address history in this application illustrates, from December 12, 2005 through March 5, 2009, that this application did not have a customer number associated with it. The email from Elsa Mebrahtu included with the petition pertains to a Data Change associated with the customer number 43831. While that data change (an address change in this instance) was effected via PRIVATE PAIR, that change did not apply to the instant application as the instant application was, at that time at least, not associated with the customer number 43831. As a result, the Notice of non-compliant amendment dated (August 26, 2008) was mailed properly to the address of the record at that time. Therefore, the petition to withdraw the holding of abandonment is dismissed.

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$1,620.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was

discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

As stated in the decision mailed July 21, 2009, the change of address submitted on March 3, 2009, appears to be improper. The Attorney and Registration number is not of record in the instant application.

Petitioner should be aware that customer number 43831 has not yet been properly associated with the above-identified application.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

By internet: EFS-Web
 www.uspto.gov/ebs/efs_help.html
 (for help using EFS-Web call the
 Patent Electronic Business Center
 at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/

Karen Creasy
Petitions Examiner
Office of Petitions

cc:

BERKELEY LAW AND TECHNOLOGY GROUP, LLP
17933 NW EVERGREEN PARKWAY, SUITE 250
BEAVERTON OR 97006

Creasy, Karen

From: Krishnamurthy, Ramesh
Sent: Monday, October 05, 2009 4:45 PM
To: Creasy, Karen
Subject: FW: Hope this data helps.

Attachments: Picture (Metafile)

Karen:

As the screen shot of the correspondence address history in this application (10/554,422) illustrates, from 12/12/2005 - 03/05/2009, this application did not have a customer number associated with it. The email from Elsa included with the petition pertains to a Data Change associated with the customer number 43831. While that data change (an address change in this instance) was effected via PRIVATE PAIR, that change did not apply to the instant application as the instant application was, at that time at least, not associated with the customer number 43831. As a result, the Notice of non-compliant amendment dated (August 26, 2008) was mailed properly to the address of the record at that time.

--Ramesh

From: Stewart, James (Trawick)
Sent: Monday, October 05, 2009 4:23 PM
To: Krishnamurthy, Ramesh
Subject: Hope this data helps.

Ramesh,

Below is the list of data changes that were processed for that application, it seems odd to have so many data changes on 3/09/09. The request are made in OPAP or the GAU. Why these changes were made are still a mystery the decimation is not available in the Image File Wrapper.

PMG151C APC Application Correspondence Address History - 10552422				
File Edit Window Help				
Begin Date	End Date	Change Reason Code	Customer No	Address
03/09/2009				BERKELEY LAW AND TECHNOLOGY C
03/09/2009	03/09/2009		43831	BERKELEY LAW & TECHNOLOGY GRO
03/09/2009	03/09/2009		43831	FAX503-439-6558
03/09/2009	03/09/2009		43831	TEL503-439-6500
03/05/2009	03/09/2009			BERKELEY LAW, AND TECHNOLOGY I
03/05/2009	03/05/2009		43831	BERKELEY LAW & TECHNOLOGY GRO
03/05/2009	03/05/2009		43831	FAX503-439-6558
03/05/2009	03/05/2009		43831	TEL503-439-6500
12/12/2005	03/05/2009			BERKELEY LAW AND TECHNOLOGY C

James Stewart
Management Services Team Lead
Patents Electronic Business Center
Team Trawick
703.682.1320 - Phone
571.273.9453 - Fax

PAIR CHANGE REQUEST REPORT

09-03-2009::11:38:42

Customer Name: Michael John Willardson **Customer Number :** 43831

Name of Individual Submitting Request: Michael John Willardson

Registration Number: 50856

Date Submitted : 05-15-2007::15:02:48 **Date Printed :** 09-03-2009::11:38:42

Date Responded : 05-15-2007::15:02:48

Previous address is as follows :

Firm or Individual Name Line 1 : BERKELEY LAW & TECHNOLOGY GROUP, LLP

Firm or Individual Name Line 2 : -

Address Line 1 : 1700 NW 167TH PLACE

Address Line 2 : SUITE 240

City : BEAVERTON

State : OR

Zip : 97006

Country : UNITED STATES

Telephone : 503-439-6500

Email Address : -

Fax : 503-439-6558

Changed address is as follows :

Firm or Individual Name Line 1 : BERKELEY LAW & TECHNOLOGY GROUP, LLP

Firm or Individual Name Line 2 : -

Address Line 1 : 17933 NW Evergreen Parkway, Suite 250

Address Line 2 : -

City : BEAVERTON

State : OR

Zip : 97006

Country : UNITED STATES

Telephone : 503-439-6500

Email Address : -

Fax : 503-439-6558

Practitioner registration number(s) to be deleted:

54431 Scout, Justin

Practitioner registration number(s) to be added:

-

User Comments:

null

Point of Contact Information:

Point of Contact Name : Julianne Flynn

Point of Contact Telephone : 503-439-6500

Point of Contact E-Mail : jflynn@bltg-ip.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

Vinod Chintamani Malshe et al.

Application No.: 10/552,422

Filed: October 7, 2005

Confirmation No.: 6676

For: BIODEGRADABLE ALIPHATIC
POLYESTERS AND
PHARMACEUTICAL COMPOSITIONS
AND APPLICATIONS THEREOF

)
) Art Unit: 1615

)
) Examiner: Caralynne E. Helm

CERTIFICATE OF TRANSMISSION

) I hereby certify that this correspondence is being
) submitted via Electronic Filing System or facsimile (571-
) 273-8300) or USPS to the Commissioner for Patents, P.O.
) Box 1450, Alexandria, VA 22313-1450 on:

9.21.09

Date of Transmission

Kristi Schroeder

Name of Person Transmitting Correspondence

Kristi Schroeder 9.21.09

Signature

Date

MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION:
PETITION UNDER 37 CFR § 1.181 (a) TO WITHDRAW HOLDING OF
ABANDONMENT

Dear Sir:

On August 26, 2008, the USPTO mailed a Notice of Non-Compliant Amendment to the Attorneys of Record in the matter cited above. However, Applicant's representative never received the Notice of Non-Compliant Amendment. Subsequently, a Notice of Abandonment was mailed on March 17, 2009, citing that Applicants had not timely replied to the Notice mailed on August 26, 2008. Applicants petitioned to withdraw the holding of abandonment because Applicants never received at the address of record the Notice mailed on August 26, 2008. That

petition was dismissed in a decision mailed on July 21, 2009. (See Exhibit A: Petition Dismissal)
This is a timely filed request for reconsideration with respect to that decision.

Applicants are calling upon the requirements of MPEP section 711.03 (c) I A with regard to consideration in this matter. That section states: "an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action." MPEP section 711.01(c) I A. Applicant is requesting that this relief specifically be granted here.

Howard Skaist, undersigned and an attorney with Applicant's representative called the Petitions Examiner in this case, Karen Creasy, on August 27th, 2009 in an attempt to determine the scope of evidence necessary to successfully have the holding of abandonment withdrawn. Applicant's representative explained to the Petitions Examiner that the address for the Attorneys of Record in this matter had been changed in 2007 via an Electronic Filing. The Petitions Examiner agreed during the call that such evidence would be compelling in establishing that the steps taken here were reasonable and that this evidence, coupled with evidence that the Notice had not been received, which had already been established in the written record, would go far in terms of obtaining a withdraw of a holding of abandonment.

Applicant's representative therefore points to Exhibit B, which was received from Else Mebrahtu of the Patent Electronic Business Center of the USPTO. This document establishes that the address for the Attorneys of Record was changed on May 15, 2007. Therefore, Applicant's representative fully expected to receive USPTO correspondence as this new address.

Now, therefore, Applicant's representative would like to further clarify the following in support of this petition:

1. On May 15, 2007, Applicant's representative, Attorneys of Record, changed their mailing address of record with the USPTO via an Electronic Filing. (see Exhibit B: email

- from Patent Electronic Business Center of USPTO) Attorneys of Record in this matter had changed their physical office location on April 7, 2007, as stated in the prior petition.
2. On September 3, 2008, the USPTO received as undelivered a Notice of Non-Compliant Amendment that had been mailed on August 26, 2008 (see Exhibit D: Printout of Notice returned to USPTO, retrieved from Private PAIR record for this matter)
 3. On March 2, 2009, Examiner Caraolynne Helm called the offices of Applicant's representative to determine the status of the present application (see Exhibit C: Affidavit of Tamara Daw).

Here, as set forth above, the Notice of Non-Compliant Amendment mailed on August 26, 2008 was returned to the USPTO as undelivered, as shown by the record on Private PAIR for the present application. Applicant's representative received no communication from the USPTO at its current offices as to the existence of this Notice of Non-Compliant Amendment until March 2, 2009 (after expiration of the six-month statutory period to respond), when Examiner Helm called the offices of Applicant's representative. Applicants, therefore, never received the August 26 Notice of Non-Compliant Amendment in time to respond. Accordingly, Applicants again respectfully request withdrawal of the holding of abandonment of the present application.

Applicants respectfully point out that throughout prosecution of the present application, Applicants have been responsive and diligent in moving the application to allowance. It was only after Applicants did not receive, and were not aware of, a Notice from the USPTO mailed to the old address of Applicant's representative that Applicants failed to respond. Per the requirements of MPEP section 711.03(c) I A, these facts provide a sufficient basis for a withdraw of a holding of abandonment.

That section of the MPEP requires the following (portions from MPEP in italics below):

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should

establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

I, Howard Skaist, Reg. No. 36,008, hereby state for the record that the offices of Berkeley Law & Technology Group, LLP, Attorneys of Record, employ the Prolaw® docketing system, available from Elite®, a Thomson Reuters business, which is used by multiple corporations and law firms to perform the docketing of patent matters. Its acceptance in the marketplace and its use by many entities beyond the Attorneys of Record in this matter demonstrates that it is a sufficiently reliable docketing system. A further factor here is that the Notice in this case was one of Non-compliance, which is not capable of being docketed until after being received by First Class Mail. The matter involved is US Patent Application Serial No. 10/552,422, attorney docket number 044.P001, the mailing date of the Notice at issue was August 26, 2008 and it was due on September 26, 2008.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

The Office action at issue was never received at the offices of the Attorneys of Record. In addition to the evidence submitted as Exhibit D, a search was made of the offices of the Attorneys of Record and all docketing personnel were questioned. Based on these facts, Applicant's representative believes that the Notice was not lost, but, rather, was never received. A copy of the docket for this matter is included as Exhibit E.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the

practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

Exhibit E contains a copy of the entire docket in this matter.

In the dismissal of the prior petition, the Petitions Examiner stated: “the evidence submitted is not convincing to substantiate the grants of a petition to withdraw the holding of abandonment in the above application.” Applicants submit that this has now been cured and sufficient evidence has now been submitted.

Likewise, the Petitions Examiner stated in the dismissal of the prior petition that the Attorneys of Record could have called the USPTO to inquire of the status of the change of address. Applicant’s representative would like to make clear that many calls were made to the USPTO in order to clarify this situation after March 2, 2008; however, the fact of those calls was not specifically mentioned in the previous petition. Therefore, Applicant’s representative has been extremely diligent in trying to clear up this matter. Furthermore, while the physical address of the attorneys of record was changed, their phone number was not changed. Therefore, an earlier call to the Attorneys of Record from the Examiner would have resulted in a timely response to the Notice. However, by the time the Examiner handling the Office action had called, the statutory period of six months to respond was already passed. Therefore, even if Applicant’s representative had responded on March 2, 2008, once made aware of the Notice by the phone call from Examiner Helm, that still would not have been sufficient to avoid a holding abandonment without the USPTO resetting the period for response, as is being requested here.

In summary, Applicant’s representative changed its address of record with the USPTO on May 15, 2007; however, because the Notice went to the wrong address and was returned, Applicant’s representative never received it. In addition, as an extra step, Applicant’s representative also subsequently changed their address of record in this specific matter as Private PAIR indicates. Therefore, again, Applicant’s representative has been extremely

diligent in trying to clear this issue. MPEP section 711.03(c) suggests that in circumstances such as these, the holding of abandonment should be withdrawn and the period for response reset. Furthermore, a reply to the Notice also accompanies this request for reconsideration. Favorable action in this regard is respectfully solicited. Any fees or extensions of time believed to be due in connection with this petition are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

Respectfully submitted,
Attorney for Applicant

Dated: /09/21/09/

/Howard A. Skaist/

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503.439.6558 (fax)

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